

### **REMARKS/ARGUMENTS**

The Applicants have carefully considered this Application in connection with the Examiner's Action and respectfully request reconsideration of this Application in view of the foregoing amendment and the following remarks.

The Applicants originally submitted Claims 1-19 in the Application. The Applicants amended Claims 1, 8 and 15 and cancelled Claim 7 without prejudice or disclaimer in a previous Amendment. In the present Amendment, the Applicants amend Claims 1-2, 8-9, 12-13, and 16-17. Accordingly, Claims 1-6 and 8-19 are currently pending in the Application. Support for the present Amendments can be found, for example, in Fig. 1, paragraphs [0023-0027] and in Figure 4 of the present Application.

#### **I. Rejection of Claims 1, 8, 12 and 16 under 35 U.S.C. §112, Second Paragraph**

The Examiner has rejected Claims 1-6 and 8-19 under 35 U.S.C. §112, Second Paragraph, for a lack of antecedent basis for various claim elements. In response, the Applicants have amended independent Claims 1, 8, 12, and 16 and dependent Claims 2, 9, 13, and 17. Therefore, the Applicants respectfully request the Examiner to withdraw the rejection to pending Claims 1, 8, 12, and 16 and allow the claims to issue

#### **II. Rejection of Claims 1-6 and 8-11 under 35 U.S.C. §101**

The Examiner has rejected Claims 1-6 and 8-11 under 35 U.S.C. §101. The Applicants respectfully disagree with the Examiner, and respectfully traverse the rejection of the Examiner.

As discussed in M.P.E.P. ¶2106.02: “If the acts of a claimed process manipulate *only* numbers, abstract concepts or ideas, or signals representing the foregoing, the acts are not being applied to appropriate subject matter. *Gottschalk v. Benson*, 409 U.S. 63, 71-72, USPQ 673, 676 (1972).” (Emphasis added.) The Applicants respectfully state that Claims 1 and 8 recite more than only manipulating numbers, abstract concepts, or ideas. For example, Claim 1 recites:

f) *using the online computer system* to compare the department identification of the department which wants to incur the capital expenditure inputted in step e) and the factors which are to be considered as the prerequisite of the approval of the desired capital expenditure *with the database and generating a table of requisite approvers* for the desired capital expenditure *based on at least a requisite number of approvals*; and g) electronically *routing* the inputted information *to each of the requisite approvers*.” (Emphasis added.)

Please note that, in an environment of an online computer system, a “table of requisite approvers” is generated, which transforms information, and which is also routed to “the requisite approvers.” Generating a table of requisite approvers, then routing to each of the requisite approvers the inputted information, is more than the mere manipulation of numbers, abstract concepts, or ideas, as contemplated by the M.P.E.P. ¶2106.02.

Therefore, the Applicants respectfully request the Examiner to withdraw the 35 U.S.C. §101 rejection to pending Claims 1-6 and 8-11 and allow the claims to issue.

### **III. Rejection of Claims 1-6 and 8-19 under 35 U.S.C. §103**

The Examiner has rejected Claims 1-6 and 8-19 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6, 741,989 to Seltzer *et al.* (“Seltzer”) in view of U.S. Patent 5,301,105 No. to Cummings, Jr., (“Cummings”), U.S. Patent No. 6,067,522 to Warady *et al.*,

("Warady"), U.S. Patent Publication No. 2003/0046422 to Narayanan *et al.* ("Narayanan") and further in view of an Official Notice.

Claim 1 is directed to a method for centralizing a capital expenditure approval process for expenditures by employees in various departments of a company. Amended Claim 1 includes: "(c) using the factors of step b) to further determine a number of levels of approvals required for each capital expenditure of a plurality of capital expenditures," and "(f) using an online computer system to compare the department identification of the department which wants to incur the capital expenditure inputted in step e) and the factors which are to be considered as a prerequisite of the approval of a desired capital expenditure with the database and generating a table of requisite approvers for the desired capital expenditure based on at least a requisite number of approvals."

For at least some embodiments of Claim 1, paragraph [0026] of the present Application states:

[F]orm 12 requires the employee to identify his/her department of employment 28. As shown in Figure 2A2 the employee selects the department of employment from a preprogrammed drop down list of department choices. Once employee 11 selects the appropriate department from the drop down list in block 28, it is permanently entered onto form 12. The selection of a department from the drop down list is the sole decider of which approvals are required because each of the departments shown at 28 in Figure 2A are preprogrammed to selected (*sic*) approval chains.

Seltzer is not cited by the Examiner as disclosing either of these steps, "step c)" or "step f)," of Claim 1.

III.A. Nor does Cummings compensate for the deficiencies of Seltzer. The Examiner does

not cite Cummings for step c) of Claim 1: "c) using the determined factors to further determine a defined number of levels of approvals required for each capital expenditures, at least one capital expenditure sought by employees in each department."

The Examiner does contend, however, that Cummings discloses at least part of step f) of Claim 1. The Examiner contends that Cummings discloses: "f) using the online computer system to compare the inputted department identification [...] (see column 7, lines 41-47, 61-65, and column 8, lines 1-20 of Cummings, where 'central processing system or a personal computer' is equivalent to 'computer system')." (See Examiner's Action, page 9.)

The Applicants respectfully traverse the characterization of Cummings as disclosing these claim elements. Cummings, column 7, lines 41-47, is directed to a general discussion of a distributed processing environment, not to comparing inputted department identification as previously claimed in Claim 1, nor to "using the online computer system to compare the department identification of the department which wants to incur the capital expenditure inputted in step e) ..." as currently amended and clarified in Claim 1.

Cummings, column 7, lines 61-65 states:

FIG. 3 also illustrates another feature mentioned above, namely, the provision of an optional high resolution display 66 preferably located in the physician's office so as to permit on-line real time display and visual review of relevant data, test results and the like. Also included &re (*sic*) representations 66a-66c which are illustrative of various reports that may be printed out or otherwise prepared in hard copy form by printer 13.

Cummings, column 7, lines 61-65, is directed to a general discussion of a presentation of data and a review of data by a physician, not to comparing inputted department identification as

previously claimed, nor to “using the online computer system to compare the department identification of the department which wants to incur the capital expenditure inputted in step e) ...” as it currently amended and clarified in independent Claim 1.

Cummings, column 8, lines 1-20, states:

Now turning to FIG. 4, the preventive health aspect of the Wellness Health Management System is illustrated. There, it will be observed, is the entry of information for each participant into the System. This is symbolized by rectangle 70. Authorization and Identification 71 are made by designees such as authorized personnel within a company personnel department or an appropriate official within an insurance company. Once authorized, a participant is provided with an appropriate identification and/or other indicia which is subsequently used by the System to *verify his authorization* to participate as well as to *identify his records and other information* and data utilized by the System in carrying out its functions. (Emphasis added.)

Next, it is contemplated that health screening is conducted as indicated at Initial Health Screening 72. Such initial health screening ordinarily includes recording health history 73 and a physical examination 74. As denoted by Data Entry items 75 and 76, relevant items of information are entered into System memory and/or manual records.

However, Cummings, column 8, lines 1-20, does not disclose *comparing inputted department identification*. Nor does Cummings, column 8, lines 20 disclose “using the online computer system to compare the department identification of the department which wants to incur the capital expenditure inputted in step e) ...” as currently amended and clarified.

Instead, at best, Cummings is directed to verifying *personal* identification and identifying ‘his’ records and data. However, Claim 1 recites comparing *department* identification of the department which wants to incur the capital expenditure inputted in step e). There is no disclosure of a “department identification” in the above cited passages of Cummings as previously or currently

amended in Claim 1. Nor is there a further disclose of a *comparison* of a "department identification" in the cited passages of Cummings as previously claimed or currently amended.

Therefore, the Applicants respectfully state that the Examiner has not met her *prima facie* burden regarding the rejection of Claim 1.

**IIIB.** The Applicants also respectfully state that Warady does not compensate for the above-discussed deficiencies of Seltzer or Cummings. The Examiner does not cite Warady for step c) of Claim 1. However, the Examiner again contends that Warady teaches at least part of step f) of Claim 1. The Examiner contends that Warady teaches:

"f) [...] generating a table of requisite approvers for said expenditure [...] (see column 5, lines 34-49, where 'table corresponding to a flexible spending' is equivalent of 'table for said expenditure')". (See Examiner's Action, page 10.)

Column 5, lines 34-49 of Warady state:

As another example, a benefit table corresponding to a life insurance (e.g., self, spouse, or child life insurance) or disability benefit could include, in addition to some or all of the information described above for the medical benefit table, minimum or maximum ages for receiving the benefit under each plan and a percentage of a maximum benefit available to the employee based upon, for example, the employee's age. As a further example, a benefit table corresponding to a flexible spending account (e.g., a dependent care or health care reimbursement account) benefit could include, again in addition to some or all of the information described above for the medical benefit table, maximum benefits available to the employee for each plan as well as a range of possible employee contributions for each plan.

The Applicants again respectfully state that they are unable to find in the above passage "generating a table of requisite approvers ..." as claimed in step f) of Claim 1. Although the cited

passage refers to a medical benefit table, this is not a *table of requisite approvers*, as recited in Claim 1.

Therefore, the Applicants again respectfully state that the Examiner has not met her *prima facie* burden regarding the rejection of Claim 1.

**IIIC.** Nor does Narayanam compensate for the deficiencies of Seltzer, Cummings or Warady. The Examiner does not cite Narayanam for either step (c) or step (f) of Claim 1 as currently amended.

Therefore, the Applicants again respectfully state that the Examiner has not met her *prima facie* burden regarding the rejection of Claim 1.

**IIIDI.** However, the Examiner takes Official Notice that other elements of independent Claim 1 are “old and well known in corporate industry.” (See Examiner’s Action, page 11.)

The Official Notice states in full:

Official Notice is taken that at least one capital expenditure, using factors to further determine a number of levels of approvals required for capital expenditure of a plurality of capital expenditures, which are to be considered as a prerequisite of approval of capital expenditure, capital expenditure being one of the plurality of the capital expenditures, and the factors which are to be considered as the prerequisite of the approval of the desired capital expenditure with the database and generating a table of requisite approvers for the desired capital expenditure base on at least the requisite number of approvals is old and well known in corporate industry as a convenient way to (*sic*) for obviating one or more problems due to limitations, i.e. wasted time and human error by an employee providing inconsistent information, and disadvantages of the related art, because standardized forms reduce the human error or to make the capital expenditure approval process more efficient. (See Examiner’s Action, pages 11-12.)

The Applicants respectfully cite to M.P.E.P. ¶2144.03(A), “Determine When It Is Appropriate To Take Official Notice Without Documentary Evidence To Support the Examiner’s Conclusion:”

It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 (“[T]he Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”). While the court explained that, “as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction,” it made clear that *such “expertise may provide sufficient support for conclusions [only] as to peripheral issues.”* *Id.* at 1385-86, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. (Emphasis added.)

The Official Notice of the Examiner does not relate to conclusions only as to “peripheral issues” as contemplated by the M.P.E.P. Instead, the Examiner has effectively taken “Official Notice” of at least all of step c) of Claim 1 and a substantial portion of step f) of Claim 1 as being “old and well known.” Therefore, the Examiner has taken an improper Official Notice. Therefore, the Applicants again respectfully state that the Examiner has not met her *prima facie* burden regarding the rejection of Claim 1.

**IIIDii.** Moreover, the Applicants respectfully disagree with the Examiner as to the factual accuracy of this Official Notice and hereby traverse these characterizations and findings. According to the M.P.E.P. ¶2144.03(C), “If Applicant challenges a Factual Assertion as Not Properly Officially



Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence: To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art."

The Applicants point to the Background of the Application, paragraph [003]: "*Up until now, the capital approval process comprised the hand transmittal of papers of various managers whose approvals were needed ....* The request form would then slowly move through the approval process so that eventually all appropriate manages individually reviewed the request and individual managers either approved it or disapproved it." (Emphasis added.) Therefore, it was not necessarily "common knowledge" that "the factors which are to be considered as the prerequisite of the approval of the desired capital expenditure with the database and generating a table of requisite approvers for the desired capital expenditure base on at least the requisite number of approvals is old and well known in the art," as contended by the Examiner, as "*[u]p until now, the capital approval process comprised the hand transmittal of papers of various managers whose approvals were needed.*" Therefore, the Applicants do not consider the Officially Noticed facts and conclusions of the Examiner to be common knowledge or well known in the art.

According to the M.P.E.P. ¶2144.04 (C), "If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding. See 37 CFR 1.104(d)(2)."

The Applicants therefore hereby request that the Examiner provide either supporting

documentary evidence on the record under the "substantial evidence" standard under the Administrative Procedure Act for the factual assertions of the Official Notice, above. Alternatively, the Applicants request that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanations to support the findings, or withdraw the rejection of independent Claim 1.

**IIIE.** The Applicants respectfully state that the Examiner has not presented a proper *prima facie* case for rejection of amended Claim 1, nor its dependent claims, in view of Seltzer, individually or in combination with Cummings, Warady, Narayanan, and the Official Notice. Furthermore, for similar reasons, the Examiner has not presented a proper *prima facie* case for rejection of independent Claims 8, 12, 16, nor their dependent claims, in view of Seltzer, individually or in combination with Cummings, Warady, Narayanan, and the Official Notice.

In view of the foregoing remarks, the cited passages of the above references do not support the Examiner's rejection of Claims 1-6 and 8-19 under 35 U.S.C. §103(a). The Applicants therefore respectfully request the Examiner withdraw the rejection and allow issuance of Claims 1-6 and 8-19.

**IV. Conclusion**

In view of the foregoing amendment and remarks, the Applicants now see all of the Claims currently pending in this Application to be in condition for allowance and therefore earnestly solicit a Notice of Allowance for Claims 1-6 and 8-19.

The Applicants request the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present Application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

HITT GAINES, PC

A handwritten signature in black ink, appearing to read 'D. Hitt', with a large circular flourish at the beginning.

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